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Appeal No. 91-2861

PAT. & T.M. OFFICE
BOARD OF PATENT APPEALS
AND INTERFERENCES

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ON BRIEF

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte Ole K. Nilssen

Application for Patent filed April 16, 1990, Serial No. 07/511,951, which is a Continuation of Serial No. 06/889,746 filed July 28, 1986, now abandoned. Track Lighting System For 277 Volt Power line.

Ole K. Nilssen pro se.

Primary Examiner - Eugene R. Laroche.
Examiner - A. Zarabian.

Before Thomas, Hairston and Cardillo, Examiners-in-Chief.

Hairston, Examiner-in-Chief.

This is an appeal from the final rejection of claims 1 through 19, all of the claims in this application.

The disclosed invention relates to a track-lighting system that is powered by a relatively low-magnitude, high-frequency voltage.

Claim 1 is illustrative of the claimed invention, and it reads as follows:

1. A track lighting system comprising:
a source providing a relatively high-magnitude low-frequency AC voltage to a pair of power line terminals;
voltage conditioning means connected with the power line terminals and operative to provide a relatively low-magnitude high-frequency AC voltage at a pair of track conductors in a power track, the power track having a receptacle slot operable to receive and hold track lighting units having socket terminals, thereby to permit electrical contact between the socket terminals and the track conductors; and
track lighting units: i) having socket terminals, ii) adapted by way of these socket terminals to be inserted into and held by the power track's receptacle slot, thereby to establish electrical contact between the socket terminals and the track conductors, and iii) adapted to be properly powered by the relatively low-magnitude high-frequency AC voltage.

The references relied on by the examiner are:

Kivari	2,587,169	Feb. 26, 1952
Neumann et al. (Neumann)	3,496,518	Feb. 17, 1970
Spira et al. (Spira)	4,207,498	June 10, 1980
Nilssen	4,506,318	Mar. 19, 1985

Claims 1 through 19 stand rejected under 35 U.S.C. 103 as being unpatentable over Spira in view of Kivari and Neumann.

Claims 1 through 19 stand rejected under 35 U.S.C. 103 as being unpatentable over Nilssen in view of Kivari and Neumann.

Reference is made to the briefs and the answer for the respective positions of the appellant and the examiner.

OPINION

All of the claims on appeal and the applied references were before the Board in application Serial No. 06/889,746. In a decision dated March 29, 1990, the prior Board held all of the claims obvious over the combined teachings of Spira, Kivari and

Appeal No. 91-2861

Neumann, and the combined teachings of Nilssen, Kivari and Neumann.

As evidence of the nonobviousness of the claimed invention, appellant is relying on affidavits submitted by Dale E. Fiene, John Giorgis, Jr. and Robert E. Schneider.

For all of the reasons stated in the answer and the prior Board decision, and for the additional reasons presented infra, we will sustain the 35 U.S.C. 103 rejection of claims 1 through 19.

Even though Messrs. Giorgis and Schneider were never provided copies of appellant's application and claims for review, they were requested to identify in their respective affidavits "desirable obvious modifications and/or applications of Spira's teachings." In In re Ole K. Nilssen, Appeal No. 91-1123, May 8, 1991, the Court of Appeals for the Federal Circuit found that similar affidavits submitted by appellant did not alter the determination of obviousness. In that appeal, the Court stated that

[T]he hypothetical person standard is not merely an aid to help an examiner or a judge evaluate a claimed invention for obviousness. Rather, the hypothetical person test is the standard for determining obviousness. Affidavits from experts with actual skill in the art may help, but do not substitute for an obviousness determination under the proper standard. Thus, Nilssen's reliance upon the affidavits...does not alter this obviousness determination.

Determining obviousness is a legal determination based on underlying factual inquiries. Graham v. John Deere Co., 383 U.S. 1, 17, 148 USPQ 459, 467 (1966). These inquiries are (1) the scope and content of the prior art, (2) the differences between the prior art and the claims at issue, (3) the level of ordinary skill in the art, and (4) any secondary considerations of nonobviousness. These inquiries require the fact finder to construe the prior art in light of the claimed subject matter. Under Nilssen's proposed test, the persons of actual skill in the art do not consider the claimed invention. Thus, they could not make these critical factual inquiries.

For all of the reasons stated by the Court in the noted appeal, and for the additional reason that the affidavits by Messrs. Giorgis and Schneider do not compare the claimed invention with all of the closest prior art, we find that the affidavits do not rebut the determination of obviousness. See In re DeBlauwe, 736 F.2d 699, 222 USPQ 191 (Fed. Cir. 1984).

Turning to the affidavit by Dale E. Fiene, the operativeness of the incandescent lamp disclosed by Kivari is questioned by the affiant because "any power-line-operated transformer of size small enough to be placed within the neck portion of an incandescent lamp (such as indicated by Kivari) can not possibly provide at its secondary winding enough power to

provide useful light output." Other than affiant's opinion as to the lack of operativeness of Kivari, no evidence of test results showing inoperativeness of such incandescent lamps has been provided by affiant. Even if such evidence could be produced by affiant, the probative value of such evidence would be highly doubtful because affiant assumed that the lamp described in Kivari is a standard size incandescent household light bulb, and because affiant failed to take into consideration that Kivari may be devoted to night lights or other relatively small lamps which generally provide "low voltage, of the order of one volt, across the secondary of the transformer."

On page 4 of the affidavit, Mr. Fiene stated that "it would be highly unusual, as well as inappropriate, to distribute the high-frequency voltage in Spira's¹ gas discharge lighting system by way of power tracks such as those described by Neumann." Notwithstanding affiants feelings concerning the inappropriateness of such an arrangement, we are still of the opinion that it would have been manifestly obvious to one of ordinary skill in the art to arrange the incandescent lamps of Spira in a track-lighting format as taught by Neumann. The test

¹ In In re Ole K. Nilssen, Appeal No. 88-1139, April 1988, the Court of Appeals for the Federal Circuit agreed with the Board that it would have been obvious to provide the Spira high-frequency energizing system, particularly for short-length conductors, in a track version.

Appeal No. 91-2861

for obviousness is what the combined teachings of the references would have suggested to the skilled artisan. See In re Keller, 642 F.2d 413, 208 USPQ 871 (CCPA 1981). The test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference.

On page 5 of the affidavit, affiant concludes that the track lighting system in Neumann operates perfectly well when powered by ordinary power line voltage, and that a 30 KHz power supply such as taught by Nilssen would not offer any discernible benefit. The conclusions reached by affiant are without merit because they do not dispute the examiner's assertion that it would have been obvious "to support Nilssen's incandescent lamp system in a track support, such as the Neumann et al track support." The examiner's statement of the rejection was not concerned with modifying Neumann to provide a higher frequency power source to power the Neumann track-lighting system.

The Fiene affidavit does not rebut the examiner's determination of obviousness.

DECISION

The decision of the examiner rejecting claims 1 through 19 under 35 U.S.C. 103 is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR

1.136(a). See the final rule notice, 54 F.R. 29548 (July 13, 1989), 1105 O.G. 5 (August 1, 1989).

James D. Thomas
Examiner-in-Chief

Kenneth W. Hairston
Examiner-in-Chief

Raymond F. Cardillo
Examiner-in-Chief

BOARD OF
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SELECTED AUTHORITIES AND PARAGRAPHS FROM MPEP

Selected Authorities

#1. "Where unobvious aspect of invention resides in recognition of source of problem, Patent Office inquiries should be directed, in part at least, to question of whether such a recognition would have been obvious to one of ordinary skill in the art; inquiry must go beyond the nature of the solution" (In re Roberts, 470 F.2d 1399, 176 USPQ 313 (1973);

#2. "A patentable invention within the ambit of 35 U.S.C 103 may result even if the inventor has, in effect, merely combined features, old in the art, for their known purpose, without producing anything beyond the result inherent in their use" (In re Sponnoble, 405 F.2d 578, 160 USPQ 243 (1969);

#3. "patentable invention may lie in discovery of source of problem even though remedy may be obvious once source of problem is identified" (In re Sponnoble, 405 F.2d 578, 160 USPQ 237 (1969);

#4. "we also believe that a more proper, albeit not exclusive, inquiry in a case such as this is to look further as to the reasons for making the combination" (In re Sponnoble, 405 F.2d 578, 160 USPQ 243 (1969);

#5. "If there is no evidence that a person of ordinary skill in the art at time of applicant's invention would have expected problem to exist at all, it is not proper to conclude that invention which solves this problem, which is claimed as an improvement of prior art device, would have been obvious to that hypothetical person". (In re Nomiya, 184 USPQ 608, 1975)

#6. "There must be a reason apparent at time invention was made to person of ordinary skill in the art for applying the teaching at hand, or use of teaching as evidence of obviousness will entail prohibited hindsight". (In re Nomiya, 184 USPQ 608, 1975)

#7. Application of Miller (57 CCPA 809, 418 F2d 1392, 164 USPQ 46) affirming the patentability of a "new use of a known process, machine, manufacture, composition of matter, or material".

#8. In re Gordon (221 USPQ 1125 -- Fed. Cir. 1984), especially as discussed in an article by Alton D. Rollins (Primary Examiner, Art Unit 129) in the May (1984) issue of Journal of the Patent Office Society.

#9. In Richdel, Inc. v. Sunspool Corp. (714 F.2d 1573 -- Fed Cir. 1983), Chief Judge Markey presented a detailed rejection of the doctrine of combination patents: "It was error for the district court to derogate the likelihood of finding patentable invention in a combination of old elements. No species of invention is more suspect as a matter of law than any other. Attempted categorization for the purpose of determining various "rules" detracts from what should be the sole question: whether the claimed invention would have been obvious within the meaning of paragraph 103. Most, if not all, inventions are combinations and mostly of old elements".

#10. In Adams (356 F.2d 998 -- CCPA 1966), the Board (of Appeals) was reversed because "neither reference contains the slightest suggestion to use what it discloses in combination with what is disclosed in the other." (356 F.2d at 1002)

#11. In Imperato (486 F.2d 585 -- CCPA 1973): although combining the references' teachings yielded the result claimed, the CCPA held that the combination was not obvious "unless the art also contains something to suggest the desirability of the combination".

#12. In Sernaker (702 F.2d at 995-96), the CAFC interpreted Imperato to mean that "prior art references in combination do not make an invention obvious unless something in the prior art references would suggest the advantage to be derived from combining their teachings".

#13. In Environmental Design (713 F.2d at 698), the CAFC stated: "That all elements of an invention may have been old (the normal situation), or some old and some new, or all new, is however, simply irrelevant" [to obviousness].

#14. In Fromson v. Advance Offset Plate (755 F.2d 1556), the CACF stated as follows. (Underlining by Applicant)

"Where, as here, nothing of record plainly indicates that it would have been obvious to combine previously separate process steps into one process, it is legal error to conclude that a claim to that process is invalid under paragraph 103."

#15. In Kimberly-Clark Corporation v. Johnson & Johnson (745 F.2d at 1449), the CAFC stated as follows. (Underlining by Applicant)

"examining all the references of record, we fail to find a clear suggestion of the claimed subject matter. ---- The holding of invalidity on the ground of obviousness is therefore reversed."

#16. In Kansas Jack (719 F.2d at 1144), the CAFC stated that "one may not use the teachings of the present invention as a guide to interpretation of the prior art".

Selected Paragraphs from MPEP (Underlining by Applicant)

706.02 Rejection on Prior Art

"After indicating that the rejection is under 35 U.S.C. 103, there should be set forth (1) the difference or differences in the claim over the applied reference(s), (2) the proposed modification of the applied reference(s) necessary to arrive at the claimed subject matter, and (3) an explanation why such proposed modification would be obvious"

706.07 Final Rejection

"present practice does not sanction hasty and ill-considered final rejections. The applicant who is seeking to define his invention in claims that will give him the patent protection to which he is justly entitled should receive the cooperation of the examiner to that end, and not be prematurely cut off in the prosecution of his case"

"The examiner should never lose sight of the fact that in every case the applicant is entitled to a full and fair hearing, and that a clear issue between applicant and examiner should be developed, if possible, before appeal is prosecuted"

"In making the final rejection, all outstanding grounds of rejection of record should be carefully reviewed, and any such grounds relied on in the final rejection should be reiterated. They must also be clearly developed to such an extent that applicant may readily judge the advisability of an appeal"

"where a single previous Office action contains a complete statement of a ground of rejection, the final rejection may refer to such a statement and also should include a rebuttal of any arguments raised in the applicant's response"

707.07(f) Answer All Material Traversed

"Where the applicant traverses any rejection, the examiner should, if he repeats the rejection, take note of the applicant's argument and answer the substance of it"

707.07(j) State When Claims Are Allowable

"When, during the examination of a pro se case, it becomes apparent to the examiner that there is patentable subject matter disclosed in the application, he shall draft one or more claims for the applicant and indicate in his action that such claims would be allowed if incorporated in the application by amendment"

"The examiner's action should be constructive in nature and when possible should offer a definite suggestion for correction"

408 Telephoning Attorney

"Present Office policy places great emphasis on telephone interviews initiated by the examiner"